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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,589	04/17/2001	Shawn E. Wiederin	CDR-00-010	7867

25537 7590 09/28/2004
MCI, INC
TECHNOLOGY LAW DEPARTMENT
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EXAMINER


SMITH, TRACI L

ART UNIT PAPER NUMBER

3629

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/836,589	WIEDERIN ET AL.	
	Examiner	Art Unit	
	Traci L Smith	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 17, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 7-9, 15-17, 23-25, 31-33 and 39-40 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Publication 20020115431 A1, Cox et al. Filing date November 20, 1996.

3. As to Claims 1, 9, 17 and 33 Cox teaches a system and method of tracking directory assistance listings displayed to a user and billing information based on directory listings. (Pg. 4 ¶¶ 00045-00047 and Claim 7.)

4. As to claims 7, 15, 23, 32 and 39 Cox teaches a system and method determining a billing including flat rate charges for each directory assistance. (Pg. 1 ¶¶ 0006 middle of paragraph)

5. As to claims 8, 16, 24, 32 and 40 Cox teaches a system and method utilizing Directory Assistance Database Source available from US West, which is a Regional Bell Operating Company formed by the break up of AT & T in 1983. (Pg. 2 ¶ 0017.)
6. As to Claim 25 Cox teaches a system for tracking directory assistance listings and preparing and storing billing information into a database. (Pg. 4-5 Claim 7.)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 2-4,6, 10-12, 14, 18-20, 22, 26-27, 30, 34-36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 20020115431 A1, Cox et al as applied to claims 1, 7-9, 15-17, 23-25, 31-33 and 39-40 above, in view of US Patent 6,212,506 B1 Shah et al; April 3, 2001; Filing date September 16, 1997.

10. As to Claims 2, 10, 18, 26, 34 Cox teaches a system and method of directory assistance tracking and billing. However, Cox fails to teach the method of receiving the request and transmitting billing information. Shah teaches a system and method of a customer database used to determine rates for calls and routing information. (C. 4 L. 23-25 and 31-33). It would have been obvious to combine the teaches of Cox with Shah at the time of invention as being able to determine call rates before placing the call saves customers from accumulating additional charges on their bills.

11. As to claims 3-4, 11-12, 19-20, 27-28 and 35-36 Cox teaches a system and method of directory assistance tracking and billing. However, Cox fails to teach the method of delivery. Shah teaches a system and method where information can be delivered via fax or computer. (C. 3 L. 13-15.) It would have been obvious to combine the teaches of Cox with Shah at the time of invention as different individuals different preferences as to type of billing delivery.

12. Claims 5-6, 13-14, 21-22, 29-30 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 20020115431 A1, Cox et al claims 1, 7-9, 15-17, 23-25, 31-33 and 39-40 as applied to claims and further in view of US Patent 6,658,455 B1 Weinman Jr; filed on December 30 1999.

13. As to claims 5, 13, 21, 29 and 37 Cox teaches an enhanced directory assistance method but fails to teach specific information available. Weinman teaches an enhanced directory assistance method that identifies the enhanced information as the URL of the listed party. (C. 8 L. 41-45). It would have been obvious at the time of invention to

combine the teachings of Cox and Weinman as they are both systems and methods of "enhanced" directory assistance.

14. As to claims 6, 14, 22, 30 and 38 Cox teaches a system and method of directory assistance and billing. Cox fails to teach a system and method that utilizes the internet network. Weinman establishing protocol between networks (C. 3. I. 47-48). It would have been obvious to combine the teaches of Cox and Weinmann at the time of invention as both enhanced directories are capable of being used on a computer systems.

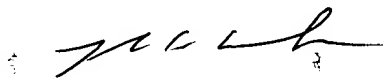
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Foreign Patent EP 633683 A2. A telephone system and information processing method with a telephone directory and a data communication function. Non-patent literature, www.searchingnetworking.techtarget.com What is a a Regional Bell Operating company?. A discussion of how the RBOC companies were formed as a result of the decree sent down from the US Supreme Court in December of 1983.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L Smith whose telephone number is (703)605-1155. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TLS



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